REMARKS

Claims 1-5, 7-12, 14-19, 23-28 and 31 are pending in the application.

Claims 6, 13, 20-22 and 29-30 are rejected.

Claims 6, 13, 20 and 29 are canceled.

Claims 1, 8, 15, 21-22 and 30-31 are amended.

Reconsideration and allowance of claims 1-5, 7-12, 14-19, 21-28 and 30-31 is respectfully requested in view of the following:

Responses to Rejections to Claims – U.S.C. §112

Claims 1-31 are rejected under 35 U.S.C. 112. Specifically, the recitation "SUTs are connected to and disconnected from a VLAN, is objected to. The suggested language includes changing "and" to -- or --, and in view of the amendments to this effort, this rejection is overcome.

Responses to Rejections to Claims – 35 U.S.C. §103

Claims 1-5, 8-12, 15-19, 23-28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al (U.S. Patent 5,027,343) (Chan) in view of Brady et al (U.S. Patent 5,914,938) (Brady). Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan in view of Brady in view of the applicants prior art. This rejection is not applicable to the amended claims.

Claims 6, 13, 20-22 and 29-30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the recitations of the base claim and any intervening claims. Inasmuch as claims 1, 8, 15, 21-22 and 30 are amended to include the allowable subject matter, these claims are submitted to be allowable.

Claim 31 is amended to include: providing a first VLAN-capable switch located at a local site; locating a first uniquely identified system under test (first SUT) at the local site and connecting the first SUT to the first VLAN-capable switch; providing a second VLAN-capable switch located at a remote site; locating a second uniquely identified SUT (second SUT) at the remote site and connecting the second SUT to the second VLAN-capable switch; providing a connection between the first VLAN-capable switch and the second VLAN capable switch such that the first and second SUTs are connected to or disconnected from a VLAN; and locating a local burn rack at the local site for receiving the SUTs such that the SUTs are configured and tested while operating together on the VLAN.

As the PTO recognizes in MPEP §2142:

> The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons:

35 U.S.C. §103(a) provides that:

> [a] patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in any combination, do not teach providing a first VLAN-capable switch located at a local site; locating a first uniquely identified system under test (first SUT) at the local site and connecting the first SUT to the first VLAN-capable switch; providing a second VLAN-capable switch located at a remote site; locating a second uniquely identified SUT (second SUT) at the remote site and connecting the second SUT to the second VLAN-capable switch; providing a connection between the first VLAN-capable switch and the second VLAN capable switch such that the first and second SUTs are connected to or disconnected from a VLAN; and locating a local burn rack at the local site for receiving the SUTs such that the SUTs are configured and tested while operating together on the VLAN.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

> [T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown

> and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, the references do not teach, or even suggest, the desirability of the combination because neither teaches nor suggests providing a first VLAN-capable switch located at a local site; locating a first uniquely identified system under test (first SUT) at the local site and connecting the first SUT to the first VLAN-capable switch; providing a second VLAN-capable switch located at a remote site; locating a second uniquely identified SUT (second SUT) at the remote site and connecting the second SUT to the second VLAN-capable switch; providing a connection between the first VLAN-capable switch and the second VLAN capable switch such that the first and second SUTs are connected to or disconnected from a VLAN; and locating a local burn rack at the local site for receiving the SUTs such that the SUTs are configured and tested while operating together on the VLAN.

Thus, neither of these references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of the claims.

In this context, the MPEP further provides at §2143.01:

> The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teaches of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the USPTO's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

Claims 1, 7-8 and 14 are rejected on the grounds of non-statutory obviousness – type double patenting as being unpatentable over claim 1 of U.S. Patent 6,654,347 in view of U.S. Patent 6,977,900.

A timely filed terminal disclaimer is filed herewith to overcome this rejection.

Therefore, independent claims 1, 8, 15, 23 and 31 and their respective dependent claims, and also independent claims 21, 22 and 30 are submitted to be allowable.

In view of all of the above, the allowance of claims 1-5, 7-12, 14-19, 21-28 and 30-31 is respectfully requested.

The amended claims are supported by the original application.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

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Dated: 5-29-07

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